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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/736,316	12/15/2003	John Gary Montana	GJE-207CD1	5453

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EXAMINER

CHANG, CELIA C

ART UNIT PAPER NUMBER

1625

DATE MAILED: 07/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/736,316

Applicant(s)

MONTANA ET AL.

Examiner

Celia Chang

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 15 December 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) 1-27 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. This application is a divisional of SN 09/777,552.

Claims 1-27 as originally filed are in the case.

2. *Election/Restrictions*

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 7, 1-6, 9-10 in part, drawn to pyridyloxy pyrans i.e. R^4R^5 is pyranyl, B is C1-6 alkyl, C2-6 alkyenyl and C2-6 alkynyl substituted with OR^7 and R^7 is pyridyl, classified in class 546, subclass 282.1+.
- II. Claims 8, 1-6, 9-10 in part, drawn to phenoxypropane sulfonyl cyclopentane carboxylic acid compounds, classified in class 560-562, subclass various, depending on species election. If this group is elected, a further election of a single disclosed species reading on R^4R^5 is cycloalkyl, B is C1-6 alkyl, C2-6 alkyenyl and C2-6 alkynyl substituted with OR^7 and R^7 is aryl.
- III. Claims 1-6, 9-10 remaining compounds, drawn to various core compounds, classified in class various, subclass various, depending on species election. If this group is elected, a further election of a single disclosed species is also required and further restriction corresponding to the elected species will be made. Please note that the subgeneric scope wherein R^4R^5 is pyranyl, B is C1-6 alkyl, C2-6 alkyenyl and C2-6 alkynyl substituted with R^6 has been issued.
- IV. Claims 17, 11-16, 18-19 in part, drawn to pyrrolidinyl compounds, classified in class 548, subclass various, depending on species election. If this group is elected, a further election of a single disclosed species is also required and further restriction corresponding to the elected species will be made.
- V. Claims 25, 17 in part, 20,-24, 26-27 in part, drawn to piperidinyl compounds, classified in class 546, subclass various, depending on species election. If this group is elected, a further election of a single disclosed species is also required and further restriction corresponding to the elected species will be made.

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- VI. Claims 11-16, 18-19, 20-24, 26-27 remaining compounds, drawn to various core compounds, classified in class various, subclass various, depending on species election. If this group is elected, a further election of a single disclosed species is also required and further restriction corresponding to the elected species will be made.

The inventions are distinct, each from the other because:

Compounds of groups I-VI differ in elements, bonding arrangement and chemical properties to such an extent that the core structures are independent and distinct as to lacking a common core. A reference anticipates one compound would not necessarily render another member in the same Markush group obvious. The search for each independent and distinct core would not be required for another core and the class and subclasses are not co-extensive. Lacking a common core is one of the criteria among the reasons for restriction. In the instant case, the search for each group is so enormous, without a species election, the appropriate class and subclass can not be defined. Therefore, it is proper to restrict the independent and distinct class of compounds.

Should applicant traverse on the ground that the groups and/or species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the groups and/or species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention. In the instant case, were restriction traversed, all the claims will be rejected under 35 USC 102(b) over Jankowski et al. CA 76:99581 and WO 99/40080.

3. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the

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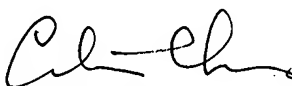
currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Celia Chang whose telephone number is 571-272-0679. The examiner can normally be reached on Monday through Thursday from 8:30 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cecilia Tsang, can be reached on 571-272-0562. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

OACS/Chang
Jun 29, 2005


Celia Chang
Primary Examiner
Art Unit 1625